

REMARKS

At the time of the Office Action dated December 17, 2003, claims 1-3 were pending and rejected in this application. Claims 1-3 have been amended to clarify the limitations recited therein. Specifically, claim 1 has been amended to recite that the inorganic filler comprises 50 to 100 % by weight hydroxyapatite, consistent with Table on page 10 of the Applicants' disclosure. Claim 3 has been amended to recite that the inorganic filler comprises 0.5 to 50% by weight talc, consistent with the amendment to claim 1. Applicants submit that the present Amendment does not generate any new matter issue.

On page two of the Office Action, the Examiner objected to the specification, asserting that both the specification and claims incorporate by reference JIS P-1824, which is an industrial standard. In response, Applicants note that the reference to JIS P-1824 has been removed from the claims. Furthermore, the specification does not "incorporate by reference" the industrial standard of JIS P-1824. Instead, the specification indicates that the measurement of g/m^2 is obtained using a technique, i.e., JIS P-1824, which is a well-known standard to one having ordinary skill in the art. Since this standard is well-known to one having ordinary skill in the art, the JIP P-1824 standard does not have to be included within the specification.

CLAIMS 1-3 ARE REJECTED UNDER THE SECOND PARAGRAPH OF 35 U.S.C. § 112

On page two of the Office Action, the Examiner asserted that the reference to JIS P-8124 in claim 1 renders the claims indefinite "as industrial standards are subject to change." This rejection is respectfully traversed.

As noted above, the reference to JIS P-1824 has been removed from the claims. Thus, the imposed rejection of claims 1-3 under the second paragraph of 35 U.S.C. § 112 has been overcome and, hence, Applicants respectfully solicit withdrawal thereof.

CLAIMS 1-3 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON EP 0393723 (HEREINAFTER EP '723) IN VIEW OF JP 11-137336 (HEREINAFTER JP '336)

Initially, Applicants note that independent claim 1 has been amended to clarify that a paper includes an inorganic filler comprising 50 to 100 % by weight hydroxyapatite and this paper selectively absorbs oxidized sebum. Thus, the paper, as recited in amended claim 1, contains 1 to 30 % by weight of inorganic filler, and the inorganic filler comprises 50 to 100 % by weight hydroxyapatite.

In reviewing the applied references, JP '336 discloses a paper that includes an inorganic filler and that content of the inorganic filler within the paper is 0.5 to 40 % by weight. However, JP '336 fails to teach or suggest that the inorganic filler comprises 50 to 100 % by weight hydroxyapatite. By having the inorganic filler comprise 50 to 100 % by weight hydroxyapatite, the paper is selectively capable of absorbing oxidized sebum, as recited in claim 1. In contrast, JP '336 does not teach or suggest that the paper is capable of selectively absorbing oxidized sebum. Thus, not only does JP '336 fail to teach or suggest the claimed range of % by weight of hydroxyapatite in the inorganic filler, JP '336 fails to teach or suggest the capability of the paper to selectively absorb oxidized sebum.

With regard to EP '723, this reference discloses a paper comprising a calcium phosphate compound having the functionality of deodorizing and adsorbing bacteria. EP '723 also discloses that apatite is one of the available calcium phosphate compounds. EP '723, however, does not teach or suggest that hydroxyapatite, among the calcium compounds, functions to selectively absorb oxidized sebum. Furthermore, EP '723 does not teach or suggest that the content of hydroxyapatite in the inorganic filler is 50 to 100 % by weight.

Based on the above analysis of the applied references, both EP '723 and JP '336 fail to teach or suggest that the content of hydroxyapatite in the inorganic filler is 50 to 100 % by weight or the capability of the paper to selectively absorb oxidized sebum. Therefore, even if the applied references were combined, as suggested by the Examiner, the claimed invention would not result. Applicants, therefore, respectfully submit that the imposed rejection of claims 1-3 under 35 U.S.C. § 103 for obviousness based upon EP '723 in view of JP '336 is not viable and, hence, solicit withdrawal thereof.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Application No.: 10/089,245

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417, and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY

A handwritten signature in black ink, appearing to read 'Scott D. Paul', written over the firm name.

Scott D. Paul
Registration No. 42,984

600 13th Street, N.W.
Washington, DC 20005-3096
(202) 756-8000 SDP:kap
Date: March 16, 2004
Facsimile: (202) 756-8087